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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/269,573 07/16/99 HAYASHIZAKI

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| EXAMINER |
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FORMAN, B

| ART UNIT | PAPER NUMBER |
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1655

DATE MAILED: 01/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/269,573

Examiner

BJ Forman

Applicant(s)

HAYASHIZAKI, YOSHIHIDE

Art Unit

1655

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2000 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
 - (b) ☐ they raise the issue of new matter. (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

4. ☐ Applicant's reply has overcome the following rejection(s): _____.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-25 27-31.
- Claim(s) withdrawn from consideration: _____.

9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.

10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

11. ☒ Other: Continuation of Advisory Action
Interview Summaries 22 Nov. 2000; 27 Nov. 2000; 30 Nov. 2000; 2Jan2000

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Continuation of Advisory Action

Regarding the rejection of Claims 1-8, 19-22 & 27-30 over Gifford (U.S. Patent No. 5,750,335) in view of Chirikjian et al. (U.S. Patent No. 5,763,178) and Chee et al. (U.S. Patent No. 5,837,832), applicant argues that the method of Gifford permits the user to examine only one sequence at a time. This argument is not found persuasive because the instant claims are drawn to a method of detecting one fragment. Additionally, the argument is not found persuasive because Gifford teaches a plurality of nucleic acids immobilized in an array (Column 5, lines 1-2) and therefore permits the user to examine more than one sequence at a time.

Applicant further argues that Chee et al. "in no way teach long probes". This argument is not found persuasive because as stated in the previous action, Chee et al. specifically teach "very long probes may be required for optimal detection" (Column 7, lines 2-5) and the primary reference, Gifford also teaches the nucleic acids are long i.e. genomic DNA, cDNA, mRNA, mitochondrial DNA, or circular DNA (Column 4, lines 50-54). Additionally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., long probes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the rejection of Claims 9-18 over Chirikjian et al. (U.S. Patent No. 5,763,178) in view of Chee et al. (U.S. Patent No. 5,837,832) and Goldrick et al. (U.S. Patent No. 5,891,629), applicant argues that Chirikjian et al. and Chee et al. do not teach a full-length sequence as a probe and Goldrick et al. do not cure the deficiencies of Chirikjian et al. and Chee et al. The argument is not found persuasive because the amended claims addressed in

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the previous rejection recite "part of" a full-length sequence which Chee et al. clearly disclose i.e. they specifically teach "very long probes may be required for optimal detection" (Column 7, lines 2-5)

Regarding the rejection of Claims 28-30 over Chee et al. (U.S. Patent No. 5,837,832) in view of Chirikjian et al. (U.S. Patent No. 5,763,178), applicant argues that neither patent suggest use of a full length sequence as a probe. This argument is addressed above.

Regarding the rejection of Claims 23-25 over Gifford (U.S. Patent No. 5,750,335) in view of Zoltukhin et al. (U.S. Patent No. 5,874,403) and Fleck et al. (Nucleic Acids Research, 1994, 22: 5289-5295) applicant argues that Gifford does not teach or suggest the use of a full-length sequence as a probe as recited in the amended claims. This argument is addressed above.


Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:45 TO 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


BJ Forman, Ph.D.
January 8, 2001


CARLA J. MYERS
PRIMARY EXAMINER